

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

After entry of the foregoing amendment, Claims 1-12 are pending in the present application. Claims 1, 11, and 12 are amended by the present amendment. No new matter is added.¹

In the outstanding Office Action, Claims 1-3, 5-7, and 9-12 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,476,930 to Roberts et al. (hereinafter "Roberts") in view of U.S. Patent No. 5,898,823 to Sorkin et al. (hereinafter "Sorkin"); Claim 4 was rejected under 35 U.S.C. 103(a) as unpatentable over Roberts and Sorkin in view of U.S. Patent No. 6,618,163 to Roosen et al. (hereinafter "Roosen"); and Claim 8 was rejected under 35 U.S.C. 103(a) as unpatentable over Roberts and Sorkin in view of U.S. Patent No. 6,665,724 to Lawrence.

Addressing now the rejection of Claims 1-3, 5-7, and 9-12 under 35 U.S.C. 103(a) as unpatentable over Roberts in view of Sorkin, that rejection is respectfully traversed.

Independent Claims 1, 11, and 12 each respectively recite structure, steps, and program code that determines whether or not each print job of interest among a plurality of print jobs is an interactive print job. Claims 2-10 depend directly or indirectly from Claim 1.

The outstanding Office Action cites only Roberts' print interface process 230 as teaching the above-noted features. In that regard, the Action states that the print interface process 230 determines "whether the print job is an interactive print job, i.e., determines whether an incoming print job is encrypted in PostScript format".²

¹ For support, see at least Applicants' Specification, page 12, lines 3-25.

² Office Action, 11/2/2005, page 2.

However, the print interface process 230 does not determine whether a print job is an interactive print job.³ Rather, the printer interface process 230 is stated as determining the particular format of print document, e.g., determining whether a print document is an application document file or a printer command file. According to Roberts:

Upon receiving a print request, *the print interface process 230 determines the particular format of the document* that is associated with a print request. For example, the particular document may be in the form of an application document file, such as a Microsoft Word® file, or *a printer command file such as a PostScript* or PCL. If the print interface process 230 determines that the document is a PDL file, then control is passed to PDL job process 200. Alternatively, if the print interface process 230 determines that a particular document is an application document file, then control is passed to the application job process 224.⁴ [emphasis added]

The determination of whether a print document is a printer command file, such as a PostScript, is not a determination as to whether a print job is an interactive print job.

The Office Action appears to conclude that the device of Roberts determines whether a print job is an interactive print job via the presumption that a PostScript document is a species of an interactive print job. However, even assuming *arguendo* that a PostScript document is a species of an interactive print job, that is not to say that (1) the “determination of whether an incoming print job is encrypted in PostScript format” is a species of (2) the determination of whether a print job is an interactive print job, for at least two reasons. First, the first determination (1) is not disclosed as having all claimed properties of the second determination (2), i.e., is not disclosed as involving the determination of whether a print job entails mutual communication between a print data generating apparatus and a printer as claimed. Second, by at least the same reasoning, the first determination (1) is not disclosed as having all inherent and disclosed properties of the second determination (2).⁵

³ Office Action, 11/2/2005, page 2.

⁴ Roberts, col. 8, lines 9-18.

⁵ According to MPEP 2141.02: “In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification.”

The Action is in further error as to Roberts because there is no teaching of the control station 108 storing a plurality of print jobs into a buffer, as noted by the Action.⁶ Rather, Roberts actually teaches an inputting of document information from a “mass storage device”, which is clearly not a buffer, to the control station 108. Further, the “mass storage device” is not arranged in the control station 108. Also, Figure 4 of Roberts does not show a “plurality of print jobs”, as noted by the Action.⁷ Only one print job, with different pages to be printed by different printers (e.g., color and monochrome), is shown.

Furthermore, one skilled in the art would not combine the teachings of Roberts and Sorkin, as proposed. The operation of Roberts’ device requires writing of different pages (e.g., color and monochrome) to different printers, as noted above. On the other hand, Sorkin requires establishing one-to-one direct/mutual communication between a client computer and a printer. If Roberts’ device was modified to operate in such a manner, then it would no longer function as intended with multiple printers used to print multiple pages. Such a modification, which would change the basic operating principles of Roberts, has been held to be non-obvious.⁸

Sorkin teaches a computer storing a printer address, so that the computer can directly address the printer for “purposes of printer related functions such as determining the printer configuration or set-up, or monitoring the printer”.⁹ Sorkin’s computer does not carry out printing, much less printing at any particular timing, as noted by the Action.¹⁰ Also, the computer of the Sorkin’s Abstract and the network server of Sorkin’s Figure 8 are not buffers, as claimed.

Accordingly, for the above-stated reasons, Applicants respectfully request that the rejection of Claims 1-3, 5-7, and 9-12 under 35 U.S.C. 103(a) as unpatentable over Roberts in

⁶ Office Action, 11/2/2004, page 2.

⁷ Office Action, 11/2/2004, page 2.

⁸ See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

⁹ Sorkin, Abstract.

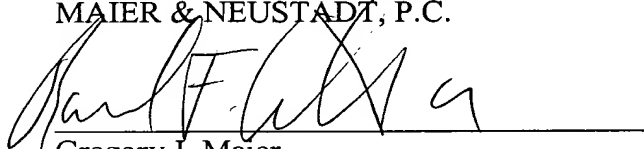
¹⁰ Office Action, 11/2/2004, page 3.

view of Sorkin be withdrawn. Further, as neither Roosen nor Lawrence cure the deficiencies of Roberts in view of Sorkin, Applicants further respectfully request that the remaining rejections, summarized above, be withdrawn.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

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